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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/682,590 | 09/25/2001 | John Hey | HEY/005/US | 5200 |

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BRIAN M. DINGMAN
MIRICK, O'CONNELL, DEMALLIE & LOUGEE, LLP
100 FRONT STREET
WORCESTER, MA 01608

| EXAMINER | |
|---|---|
| YOUNG, JOHN L | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3622 | |

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/682,590 | HEY, JOHN | |
| | Examiner | Art Unit | |
| | John L Young | 3622 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *25 September 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

9-20-2004

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/20/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

# FIRST ACTION REJECTION

**(Paper# 9/20/2004)**

## DRAWINGS

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

## CLAIM OBJECTIONS—Minor Informalities

2. "While there is no statutory form for claims, the present Office practice is to insist that. . . ." the claims must be the object of a sentence starting with 'I (or we) claim,' 'The invention claimed is' (or the equivalent)." Therefore, at the top of the first page of the claims, delete the word "Claims" and replace it with either the phrase: - -I claim- - or - -The invention claims is- -.

Also, it is common practice to indicate claims by writing:

Claim 1 . . .

Claim 2 . . . etc.

Therefore, at the first line of each claim delete the brackets and the letter "c" and insert the word - -Claim- - followed the appropriate Arabic number; for example, for claim 1 at line, 1 delete "[c1]" and replace it with - -Claim 1- -.

**CLAIM REJECTIONS – 35 U.S.C. §101**

35 U.S.C. §101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

3. Claims 1-14 are rejected under 35 U.S.C. 101, because said claims are directed to non-statutory subject matter.

As per claims 1-14, as drafted said claims are not limited by language within the technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b), even though said claims are limited by language to a useful, concrete and tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75, 47 USPQ 2d at 1602 (Fed Cir. 1998); *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999).

Note: it is well settled in the law that "[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims." (See MPEP 2173.05( q )).

**CLAIM REJECTIONS — 35 U.S.C. §103( a )**

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-14 are rejected under 35 U.S.C. §103( a ) as being obvious over Hamzy 6,636,247 (10/21/2003) [US f/d: 1/31/2000] (herein referred to as "Hamzy").

As per independent claim 1, Hamzy (col. 6, ll. 66-67; and col. 7, ll. 1-10) discloses: *"Another method to extend advertisement viewing is to display the advertisement with a question and give a number of URLs where the answer is hidden. This is shown in* ***FIG. 8****. . . . The user will not be able to proceed without giving the correct answer. Alternatively, the text of the advertisement maybe displayed and a question about the text must be answered before proceeding."*

Hamzy (the ABSTRACT; FIG. 3; FIG. 4; FIG. 6; FIG. 7; FIG. 8; FIG. 9; FIG. 10; col. 2, ll. 10-30; col. 4, ll. 60-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; & col. 8, ll. 1-25) implicitly shows all the elements and limitations of claim 1; however,

Hamzy lacks explicit recitation of "presenting the advertisement to the viewer; presenting, proximate the advertisement, at least one question whose answer can be gotten by reading the advertisement; and requiring the viewer to answer correctly at least one such question in order to proceed."

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Hamzy (col. 6, ll. 66-67; and col. 7, ll. 1-10) inherently shows those elements and limitations not explicitly recited, and it would have been obvious to modify and interpret the disclosure of Hamzy cited above as inherently showing those elements and limitations not explicitly recited, because modification and interpretation of the cited disclosure of Hamzy would have provided means for *"the display of advertisements in computer networks. . . ."* (see Hamzy (col. 1, ll.5-13)), based on the motivation to modify Hamzy so as to provide methods *"for extending viewing time*

*of advertisements on a client browser operating in a distributed server computer environment. . . .*" (see Hamzy (col. 1, ll.5-13)).

As per dependent claims 2-15 Hamzy implicitly shows method of claim 1 and subsequent base claims depending from claim 1.

Hamzy (the ABSTRACT; FIG. 3; FIG. 4; FIG. 6; FIG. 7; FIG. 8; FIG. 9; FIG. 10; col. 2, ll. 10-30; col. 4, ll. 60-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; & col. 8, ll. 1-25) implicitly shows all of the elements and limitations of claims 2-15; however,

Hamzy lacks explicit recitation of some of the elements and limitations of claims 2 –15.

"Official Notice" is taken that both the concepts and the advantages of all of the elements and limitations of claims 2-15, were well known and expected in the art by one of ordinary skill at the time of the invention because; for example, it would have been obvious to modify and interpret the disclosure of Hamzy cited above as showing all of the elements and limitations of claims 2-15, because modification and interpretation of the cited disclosure of Hamzy would have provided means for *"the display of advertisements in computer networks. . . .*" (see Hamzy (col. 1, ll.5-13)), based on the motivation to modify Hamzy so as to provide methods *"for extending viewing time of advertisements on a client browser operating in a distributed server computer environment. . . .*" (see Hamzy (col. 1, ll.5-13)).

## CONCLUSION

5. Any response to this action should be mailed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh Floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

John L. Young

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Primary Patent Examiner

September 20, 2004